

REMARKS/ARGUMENTS

In the Office Action, the Examiner has rejected claims 7, 10, and 11 as being anticipated by Liebscher and claims 4-11 as being obvious over Bartneck as modified by Liebscher. As will be further discussed below, Applicant respectfully traverses these rejections.

With respect to the Examiner's rejection of independent claim 7 based on being anticipated by Liebscher, claim 7 particularly claims that an edge of an inner sole is placed on an edge of a casting mold.

According to Fig. 5 of Liebscher, a lasting (inner) margin 10 of a *welt* is fastened to an insole 19 (see column 1, line 48), wherein the outer margin (outward extension 15) of the welt is placed on the edge of a casting mold 25. Therefore, the insole is not directly placed on the edge of the casting mold, as claimed by Applicant in independent claim 7. Therefore, Applicant respectfully submits that independent claim 7 is allowable over Liebscher for at least this reason.

Further, Applicant respectfully submits that even if in any way the welt could be considered as a part of the insole, the edge of the shoe upper piece is not pressed into the inner side of the insole since the mold last 9 is provided with a step for receiving the end portion of the upper piece. This results in a step-like transition between the upper piece and the welt and not in the smooth transition according to the present invention since the edge of the shoe upper piece is not pressed into the inner side of the insole, as claimed by Applicant.

Therefore, for at least this additional reason, Applicant respectfully submits that independent claim 7 is allowable over Liebscher.

Regarding the Examiner's rejection of independent claim 4 as being obvious over Bartneck in view of Liebscher, the Examiner argues that the only difference between Bartneck and the subject matter of claim 4 is that the inner sole is not placed on the edge of the casting mold. Applicant respectfully submits that this feature is not the only difference between Applicant's invention as claimed in independent claim 4 and Bartneck.

Claim 4 further claims the features where:

the upper is fixed internally to the inner sole; and

the shoe base material presses the inner sole against an edge of the upper that is adjacent to the fillet.

“Fixed internally” means that the end portion 12 of the upper piece 7 is arranged between the inner sole 5 and the fillet 9 and can be fixed in this area to the inner sole. Since the upper 7 lays adjacent to the fillet 9, it can be pressed against the fillet. See Figure 1.

According to Bartneck, the inner sole is fastened to the upper piece in that the margins of the upper piece and the inner sole are directed outwardly, wherein the margin of the upper piece is held between the upper mold and the lower mold, and the margin of the inner sole rests against the underside of the margin of the upper piece. When the base material expands, the sole is pressed against the upper piece in an area in which the margin of the upper piece is pressed onto the edge of the upper mold which protrudes over the edge of the lower mold.

Therefore, Bartneck does not disclose that the upper piece is *fixed internally* to the inner sole and that the inner sole is pressed against the *edge of the upper piece that is adjacent to the fillet*.

Thus, the difference between independent claim 4 and Bartneck does not only consist in that the roles of the upper piece and the inner sole are inverted. Further, even if the roles of the upper piece and the inner sole are inverted, as argued by the Examiner when modifying Bartneck by Liebscher, this still does not lead to the present invention according to claim 4. Inverting the roles would mean that the margin of the upper piece is shortened and the margin of the inner sole is elongated so that the margin of the inner sole reaches between the upper mold and lower mold. Applicant has respectfully attached a drawing of the configuration that would result from the Examiner’s argued modification. As can be seen, even with the Examiner’s argued modification, the margin of the

inner sole 14 is not pressed against the upper piece 10 adjacent to the fillet, as claimed by Applicant in independent claim 4.

Further yet, whereas the Examiner argues that inverting the roles of the upper piece and the inner sole would merely be a question of aesthetic preferences, inverting the roles would lead to quite a different appearance than that of the Bartneck design, and thus, change the principle of operation of Bartneck and render Bartneck unsuitable for its intended purpose, both of which are impermissible.

Regarding the Examiner's argument that there would be motivation to modify Bartneck to invert the roles of the upper piece and the inner sole based on Liebscher, as discussed above, Liebscher does not disclose that the inner sole is placed over the edge of the mold. In contrast, a welt is placed on the edge of a casting mold 25. Therefore, Liebscher does not teach to place the lip of the inner sole on the edge of the mold, but rather, the lip of a welt is placed on the edge of the mold. Therefore, contrary to the Examiner's argument, Liebscher provides no teaching that could result in modifying Bartneck such that Bartneck's inner sole is placed on the edge of the casting mold. Again, Liebscher discloses a welt. In fact, this has the disadvantage that two transitions are formed in the bottom of the shoe, i.e., a step between the inner sole 19 and the welt and a step between the upper piece and the welt. To avoid harming the foot of the person wearing the shoe, both steps have to be finished to form a wedge shape. According to the invention of independent claim 4, there is only one transition between the upper piece and the inner sole which minimizes the likelihood of doing harm. Additionally, the upper piece is pressed into the inner sole (as shown in Fig. 2) so that a flat, smooth transition is achieved without having to form the end portion of the upper piece to be wedge-like. Therefore, again, Liebscher does not disclose what the Examiner argues it discloses, and even if Bartneck could be modified by Liebscher, the modified Bartneck reference still does not disclose Applicant's invention as claimed in independent claim 4.

Regarding the Examiner's rejection of independent claim 7 as being obvious over Bartneck in view of Liebscher, the Examiner again argues that the only difference between Bartneck and the subject matter of claim 7 is that the inner sole is not placed on the edge of the casting mold. However, Applicant respectfully submits that Bartneck does not disclose the feature of Applicant's invention of claim 7 where the edge of the shoe upper piece is **pressed into** the inner side of the inner sole. Further, as discussed above, Applicant respectfully submits that Liebscher provides no teaching for modifying Bartneck as argued by the Examiner, and as also discussed above, even if Bartneck can be modified by Liebscher, the modified Bartneck reference still does not disclose the feature where the edge of the shoe upper piece is **pressed into** the inner side of the inner sole. A transition would be formed in the bottom of the shoe between the upper piece and the welt. Therefore, Applicant respectfully submits that independent claim 7 is also allowable over Bartneck and Liebscher.

Further in this Amendment, Applicant has added new independent claim 16. Independent claim 16 includes the features of dependent claim 8 where the step of pressing the edge of the shoe upper piece into the inner side of the inner sole includes the step of expanding a shoe base material. Since the Examiner has not rejected dependent claim 8 based on Liebscher, Applicant respectfully submits that new independent claim 16 is allowable over Liebscher. Additionally, new claim 16 includes the features of independent claims 4 and 7 discussed above. Therefore, for at least the reasons discussed above, Applicant respectfully submits that new claim 16 is allowable over Bartneck and Liebscher.

Lastly in this Amendment, Applicant has cancelled withdrawn claims 12-15.

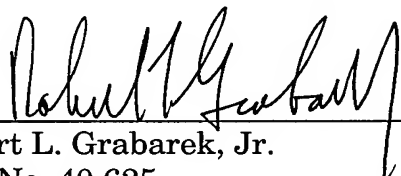
Applicant respectfully submits that the application is in condition for allowance. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

As provided for above, this paper includes a Petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees, or credit any overpayment of fees, to Deposit Account No. 05-1323 (Docket No. 056310.57444US).

Respectfully submitted,

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